

REMARKS

The Non-Final Office Action mailed December 12, 2007, has been received and reviewed. Claims 1-3, 5-15, and 18-31 are pending in the subject application. Claims 1, 8, 13, and 23 have been amended as set forth above. Care has been exercised to introduce no new matter. Reconsideration of the pending application in view of the amendments and the following remarks is respectfully requested.

Claim 1, as herein amended, now recites “determining a stack size for the plurality of files, wherein the stack size corresponds to the number of individual files that form the plurality of files.” Independent claim 23 has been amended herein to recite a similar feature. Dependent claim 8 has been amended herein to recite “generating different stack icons to represent files in different libraries, wherein each of the said stack icons displays information representative of the content of files in the distinct library.” Independent claims 13 and 23 have been amended herein to recite similar features.

In the Office Action of December 12, 2007, the Office notes in the Response to Argument section that “Applicant’s arguments with respect to claims filed in 11/21/07 have been considered but are deemed moot in view of the new grounds of rejection.” However, the grounds for rejection in the December 12, 2007, Office Action appear to be identical to that of September 21, 2007, Office Action. Applicants respectfully request that the Office consider those arguments, which are reiterated herein, if they choose to maintain the rejections of the claims.

Rejections based on 35 U.S.C. § 103(a)

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design

community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

B. Rejections based on U.S. Patent No. 5,835,094 to Ermel et al. in view U.S. Patent No. 5,680,563 to Edelman et al. in view U.S. Patent No. 6,243,724 to Mander et al. and further in view of U.S. Patent No. 6,466,228 to Ulrich et al.

Claims 1-3, 5-15 and 18-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ermel et al., U.S. Patent No. 5,835,094 (hereinafter the “Ermel reference”) in view of Edelman, U.S. Patent No. 5,680,563 (hereinafter the “Edelman reference”) and Mander et al., U.S. Patent No. 6,243,724 (hereinafter the “Mander” reference) and further in view of Ulrich et al., U.S. Patent No. 6,466,228 (hereinafter the “Ulrich reference”). It is noted that the Office has cited to U.S. Patent No. 6,466,227, but it is believed this is a typographical error. It is assumed that the Office intended to cite to U.S. Patent No. 6,466,228 to Ulrich.

Independent claim 1 recites, among other features, “determining a stack size for the plurality of files, wherein the stack size corresponds to the number of individual files that form the plurality of files,” “comparing the stack size with a predefined range of stack icon sizes, wherein said range is subdivided into at least three stack size sub-ranges” and “identifying one of the sub-ranges into which the determined stack size falls.” The Office Action concedes that the Ermel reference and the Edelman reference fail to teach or suggest such features, and alleges that the Mander reference and the Ulrich reference combine to teach such features. Applicants respectfully submit that the Ermel, Edleman, Mander, and Ulrich references, either alone or in

combination, fail to teach or suggest all the claims limitations of claim 1, and as such, Applicants respectfully traverse this rejection, as hereinafter set forth.

The Office Action primarily relies on the Mander reference for the rejections of “comparing the stack size with a predefined range of stack icon sizes, wherein said range is subdivided into at least three stack size sub-ranges” and “identifying one of the sub-ranges into which the determined stack size falls.” However, as Applicants noted in the June 22, 2007, Amendment, the Mander reference does not compare a stack size with a predefined range of stack icon sizes, and identify a sub-range into which the determined stack size falls. The Mander reference does not need any such predefined range, comparison or identification, since all documents in the Mander pile are shown in the pile icon. Indeed, the Mander reference expressly favors having each document represented individually in the pile icon, so that the user can move a cursor up or down over the pile icon to select a particular document in the pile based on where the cursor is in relation to the pile. *Mander reference*, col. 10, lines 4-20. The Mander reference fails to teach or suggest comparing a stack size with predefined range of stack sizes, and identifying one of the sub-ranges into which the determined stack size falls, as recited.

The Office cites two specific portions of the Mander reference for this predefined range. Applicants respectfully submit that neither of these portions teaches or suggest the recited features. First, the “Create and Display Pile” step of Figure 19 is part of a general process of searching documents (which is described beginning at col. 32, line 33). As described in the Mander reference, the user first enters the search terms (e.g., by specifying a set of terms, or entering a document vector) and weights, and the system then displays the search results. The Mander reference user has the option of choosing a sample document as the basis for the search, and in the cited step, the search results are sorted based on the ones that are closet to the sample

document (see col. 33, lines 15-17). Nowhere in this discussion is there any teaching or suggestion of “comparing the stack size with a predefined range of stack size icon sizes, where said range is subdivided into at least three stack size sub-ranges” and “identifying one of the sub-ranges into which the determined stack size falls,” as recited in claim 1.

The second portion cited by the Office is Figure 20, and specifically steps 955 and 963. In those portions, the Mander reference describes color-coding the pile so that documents are colored according to some criteria, such as the date. Again, it is unclear what the Office believes is the “predefined range of stack icon sizes” in this section. Applicants respectfully submit that there is no teaching or suggestion of such a predefined range of stack icon sizes.

The Ulrich reference does not serve to overcome this deficiency. The Ulrich reference describes desktop themes for a graphical user interface (GUI), and in the cited Figure 2C shows that one “Look and Feel” option allows the user to choose from three icon sizes (e.g., small, medium and large) to be used in the “List View.” There is no teaching or suggestion that these icon sizes correspond in any way to the stack size of a plurality of files that are to be represented by a stack icon. Instead, the sizes appear to simply allow the user to choose one default size for all displayed items. There is still no comparing a stack size with a predefined range of stack sizes, and identifying one of the sub-ranges into which the determined stack size falls, as recited in claim 1.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 1. Claim 1 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 2-3, 5, 7-12, and 29 depend from claim 1, and as such, are patentable over the cited references for at least the reasons cited above. Moreover, claims 2-3, 5, 7-12, and 29

recite further novel, non-obvious features not taught or suggested in the cited references. For example, claim 5 recites wherein one of the sub-ranges is a maximum range identified by a minimum size, and the identifying one of the sub-ranges includes determining whether the determined stack size exceeds said size minimum. In support of the rejection of claim 5, the Office cites to the Mander reference at Figure 18b and its subpiles. Figure 18b is described as permitting a user to identify the number of subpiles that are to be created from an original pile. *Mander reference*, col. 31 lines 13-18. There is no teaching or suggestion of what, if anything, is the alleged “maximum range identified by a minimum size,” or of “determining whether determined stack size exceeds said size minimum.” Indeed, the description makes no mention at all of any size minimums or maximums. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C § 103(a) rejection of claims 2-3, 5, 7-12, and 29 as well. Claims 2-3, 5, 7-12, and 29 are believed to be in condition for allowance and such favorable action is respectfully requested.

Independent claim 13 recites, among other features “assigning a first size range to a first one of said predefined stack icons.” The Office cites to the Mander reference and the pile described therein in support for the rejection of this feature. It is not evident where this feature is taught or suggested in the Mander reference. As discussed above, the Mander reference dynamically edits its pile icons to increase or decrease in size as documents are added or removed, there is no such size range assigned to a predefined stack icon, as recited in claim 13.

Claim 13 additionally recites, “assigning a minimum size to a third one of said predefined stack icons, said third one of said predefined stack icons being a maximum size icon.” The Office relies on the Mander reference for support of the rejection of this feature. What is the alleged minimum size of the Mander reference’s alleged maximum size icon? It is also unclear

what the Office alleges constitutes a maximum size icon in the Mander reference. The Mander reference dynamically changes its pile icon, and there is no teaching or suggestion of a minimum size of a maximum size icon.

Claim 13 goes on to recite a “step of selecting comprises the step of comparing a size of said plurality of files with said first range or said minimum size.” The Office cites that pile height change of the Mander reference discussed above, but there is still no explanation of how, or why, the Mander reference would even do such a selecting. The Mander reference does not disclose comparing a size of a plurality of files with a first range or a minimum size. The dynamic adjustment of the Mander reference’s pile height simply increases or decreases the height with each document added or removed – no comparison is shown or needed in the Mander reference.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. 103(a) rejection of claim 13. Claim 13 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 14-15, 18-22, and 30-31 depend from claim 13, and are therefore patentable for at least the reasons cited above. Moreover, claims 14-15, 18-22, and 30-31 recite further novel, non-obvious features not taught or suggested in the cited references. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 14-15, 18-22, and 30-31 as well. Claims 14-15, 18-22, and 30-31 are believed to be in condition for allowance and such favorable action is respectfully requested.

Independent claims 23 recites, among other features, “comparing the stack size to a plurality of stack size boundaries that divide a stack size range into three or more sub-ranges.” The Office fails to identify any such boundaries. The Office relies on the Mander reference in

support of this rejection, but fails to identify where in Mander any boundaries are found. As noted above, the pile height of the Mander reference simply increases or decreases by one for each file that is added or removed from the pile, and no such boundaries are used.

Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 103(a) rejection of claim 23. Claim 23 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 24-28 depend from claim 23, and are therefore patentable for at least the reasons cited above. Moreover, claims 24-28 recite further novel, non-obvious features not taught or suggested in the cited references. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 103(a) rejections of claims 24-28 as well. Claims 24-28 are believed to be in condition for allowance and such favorable action is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-3, 5-15, and 18-31 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or ahale@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due with this Amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112, referencing attorney docket no. MFCP.139661.

Respectfully submitted,

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